

REMARKS

Reconsideration of the Office action mailed February 28, 2005 is requested in view of the foregoing amendments and the following remarks.

Special Circumstances

The Examiner asked applicant to point out information material to the instant application if the criterion for materiality applies and if the examination record provides reason for applicant to believe that the Examiner has not considered such information. Applicant is uncertain what the Examiner is requesting. Applicant has previously identified information and applicant believes that identification satisfies its duty of disclosure. Nevertheless, in an attempt to respond to the request, applicant has attached to the end of this document a list of its patents and patent applications. The Examiner is requested to inform applicant if further information is needed.

Double Patenting

The Examiner stated: "It should be noted that for the purpose of this office action the below rejections under 35 U.S.C. 101 (double patenting) are being made under the assumption that the applications were not commonly owned at the time of applicant's invention." (Office Action, 2.) Applicant is uncertain what the Examiner means by this statement. The double patenting rejections set forth in the Office Action were made under the judicially created doctrine of obviousness-type double patenting, not under 35 U.S.C. 101, so applicant does not understand why reference was made to that statute. Additionally, as far as applicant is aware, obviousness-type double patenting rejections are made

between commonly owned applications so applicant does not understand why the assumption was made that the applications were not commonly owned. The Examiner is requested to inform applicant if further information concerning these points is needed.

The Examiner also stated: "Additionally, it should be noted that the below double patenting rejections are based upon known and available co-pending applications and although it is believed that all appropriate rejections have been made, applicant's help in determining all appropriate double patenting rejections with all of applicant's applications is requested because of the large number of similar applications." (Office Action, 2.) Applicant is uncertain what help the Examiner is requesting. To the extent the Examiner is asking for identification of co-pending applications, then, as stated above, applicant has attached to the end of this document a list of its patents and patent applications. Additionally, to the extent that applicant is aware of any double patenting issue, applicant will take some action to address or defer the issue, such as by amending or canceling claims, by traversing the rejection, by filing a terminal disclaimer, or by taking some other action. The Examiner is requested to inform applicant if further information concerning this issue is needed.

The Examiner made a number of obviousness-type double patenting rejections and those rejections are addressed below.

1. Application No. 10/251,576.

The Examiner provisionally rejected claim 1 under the judicially created doctrine of obviousness-type double patenting in light of claims 11-20 from co-

pending application 10/251,576. That rejection is traversed because claim 1 from the present application is patentably distinct from the cited co-pending claims. Claim 1 is patentably distinct because it describes a woodworking machine while the cited co-pending claims describe a method of minimizing injury from a router.

A prior restriction requirement in the present application confirms that claim 1 is patentably distinct. Claim 15 in the present application set forth a method for minimizing potential injuries from a woodworking machine and that method included the limitation of retracting the cutting tool away from the person. In a restriction requirement mailed January 13, 2004, the Examiner concluded that the method of claim 15 was patentably distinct from the machine recited in claim 1 and therefore subjected the claims to a restriction requirement. It is inconsistent now to say that claim 1 is obvious in light of the method of the cited co-pending claims when the prior restriction requirement said claim 1 was patentably distinct from the method of claim 15.

Applicant also traverses this double patenting rejection because it results in unequal treatment under the patent laws. Specifically, this double patenting rejection prevents applicant from receiving separate and sequential patents to inventions developed at different times because one application includes claims that dominate claims in the other application, even though others could obtain separate and sequential patents. For example, if a third party invented the method set forth in the cited claims of the co-pending application, then both applicant and the third party could patent their respective inventions without receiving a double patenting rejection even though some claims may dominate

others. If unrelated parties can file separate and sequential applications to different inventions without invoking a double patenting rejection, then a single party should be able to do likewise. That is the situation in the case at hand. The applications at issue are separate and sequential applications to different inventions and should not raise a double patenting rejection. Any other result unfairly prejudices inventors who subsequently file applications claiming different inventions. The issues of claim dominance and double patenting must not be confused. MPEP 804(II) at 800-20.

Finally, the policy behind a non-statutory obviousness-type double patenting rejection is "to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent." MPEP 804(II)(B) at 800-22 (citations omitted). That is not an issue in the present case because there would be no unjustified or improper extension of patent term if the double patenting rejection were withdrawn. The cited co-pending claims are different in scope and coverage so the term of claim 1 from the present application would not be extended.

2. Application No. 09/955,418.

The Examiner provisionally rejected claims 1, 5, 8 and 10 under the judicially created doctrine of obviousness-type double patenting in light of claims 1, 9-12 and 14-19 from co-pending application 09/955,418. That rejection is traversed. First, claim 8 in the present application has been cancelled without prejudice and therefore the rejection of that claim is moot. Additionally, co-pending claims 1, 9 and 14-19 have been cancelled and therefore the rejection based on those claims is moot. The remaining claims 1, 5 and 10 in the present

application are patentably distinct from the cited co-pending claims because they describe a woodworking machine generally while the cited co-pending claims describe up-cut chop saws. Additionally, claims 1, 5 and 10 in the present application are prior in time to the cited co-pending claims. Thus, the applications at issue are separate and sequential applications to different inventions and should not raise a double patenting rejection even though some claims may dominate other claims. Any other result unfairly prejudices inventors who subsequently file applications claiming different inventions, as explained above.

Claim 10 in the present application also requires a braking component configured to engage the cutting tool, where engagement of the braking component with the cutting tool causes the cutting tool to pivot away from the cutting region. The cited co-pending claims do not disclose any system to pivot a cutting tool away from a cutting region. This is another reason why claim 10 is patentably distinct.

There also would be no unjustified or improper extension of patent term if this double patenting rejection were withdrawn because the claims at issue are different in scope and coverage.

3. Application No. 09/676,190.

The Examiner provisionally rejected claims 1, 5, 8 and 25-29 under the judicially created doctrine of obviousness-type double patenting in light of claims 25-29 and 35-40 from co-pending application 09/676,190. That rejection is traversed. First, claims 8 and 25-29 in the present application have been cancelled without prejudice and therefore the rejection of those claims is moot.

The remaining claims 1 and 5 are limited to machines with a detection system adapted to detect contact between a person and the cutting tool while the cited co-pending claims are not so limited. Therefore, claims 1 and 5 in the present application are patentably distinct and not obvious in light of the cited claims.

The prior restriction requirement in the present application supports the conclusion that claims 1 and 5 are patentably distinct from claims that require something other than contact detection systems. Original claim 3 in the present application required a detection system to detect dangerous proximity between a person and the cutting tool rather than contact, and the Examiner restricted claim 3 because of that difference. (Office action mailed 1/13/04 at 3.) That restriction supports the conclusion that contact detection systems are patentably distinct from other detection systems.

There also would be no unjustified or improper extension of patent term if this double patenting rejection were withdrawn because the claims at issue are different in scope and coverage.

4. Application No. 10/051,782.

The Examiner provisionally rejected claims 8, 10 and 29 under the judicially created doctrine of obviousness-type double patenting in light of claims 1, 4, 5, 7 and 20-35 from co-pending application 10/051,782. That rejection is traversed. First, claims 8 and 29 in the present application have been cancelled without prejudice and therefore the rejection of those claims is moot. Claim 10 is patentably distinct for the reasons given above, including the fact that claim 10 requires a braking component configured to pivot a cutting tool away from a

cutting region. There also would be no unjustified or improper extension of patent term if this double patenting rejection were withdrawn because the claims at issue are different in scope and coverage.

5. Application No. 10/643,296.

The Examiner provisionally rejected claims 1, 5, 8, 10, 25-27 and 29 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-10 from co-pending application 10/643,296. That rejection is traversed. First, claims 8, 25-27 and 29 in the present application have been cancelled without prejudice and therefore the rejection of those claims is moot. The remaining claims in the present application are patentably distinct from the cited co-pending claims because they describe a woodworking machine generally while the cited co-pending claims describe miter saws. Additionally, claims 1, 5 and 10 in the present application are prior in time to the cited co-pending claims. Thus, the applications at issue are separate and sequential applications to different inventions and should not raise a double patenting rejection even though they may dominate the cited co-pending claims. Any other result unfairly prejudices inventors who subsequently file applications claiming different inventions, as explained above. Claim 10 is also patentably distinct because it requires a braking component configured to pivot a cutting tool away from a cutting region. Finally, there would be no unjustified or improper extension of patent term if this double patenting rejection were withdrawn because the claims at issue are different in scope and coverage.

6. Application No. 10/794,161.

The Examiner provisionally rejected claims 1, 5, 8 and 10 under the judicially created doctrine of obviousness-type double patenting in light of claims 1-20 from co-pending application 10/794,161. That rejection is traversed. First, claim 8 in the present application has been cancelled without prejudice and therefore the rejection of that claim is moot. The remaining claims 1, 5 and 10 are patentably distinct from the cited co-pending claims because they describe a machine generally while the cited co-pending claims are more specific. In other words, the cited claims in the present application may be thought of as genus claims while the cited co-pending claims may be thought of as species claims. Because the claims differ in scope and coverage, they are patentably distinct and separately patentable even though the genus claims may dominate the species claims. Claim 10 is also patentably distinct because it requires a braking component configured to pivot a cutting tool away from a cutting region, as explained above. Finally, there would be no unjustified or improper extension of patent term if this double patenting rejection were withdrawn because the claims at issue are different in scope and coverage.

Claim Rejections – 35 USC §103

The Examiner rejected claim 1 under 35 USC 103(a) as obvious in light of German Document DE 19609771 (hereinafter DE '771) in view of Friemann (US Patent 3,858,095). That rejection is traversed.

DE '771 discloses a safety system for a circular saw bench. The safety system includes a sensor to detect if a hand approaches too close to the blade. If

the hand is detected, then a pneumatic or hydraulic cylinder lowers the blade. Friemann discloses a protective circuit for a band cutter. The protective circuit does not detect proximity between a hand and blade; rather, the circuit detects actual contact. If contact is detected, then the circuit triggers a clamp brake and an electromechanical brake to stop the band cutter.

The Examiner says it would have been obvious to combine the contact detection system of Friemann with the retraction system of DE '771 to arrive at the invention set forth in claim 1. Applicant disagrees because there is no teaching or suggestion to combine those two references. To the contrary, the combination would change the principle of operation of the device disclosed in DE '771 and that is prohibited in an obviousness analysis. MPEP 2143.01; In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principle of operation of the device disclosed in DE '771 is to detect a hand before it contacts the blade. Detecting the hand before it contacts the blade avoids any injury and provides time to lower the blade. If that system were changed to detect contact, then the hand would be injured and there would be no time for the cylinder to lower the blade. Thus, changing to a contact detection system as disclosed in Friemann would change the principle of operation of the device and defeat the safety that the inventors were trying to achieve. There simply is no reason to change from proximity to contact detection if proximity detection worked reliably.

The prior restriction requirement in the present application also illustrates that a contact detection system is different from a proximity detection system. Original claim 3 in the present application required a detection system to detect

dangerous proximity between a person and the cutting tool rather than contact, and the Examiner restricted claim 3 because of that difference. (Office action mailed 1/13/04 at 3.) That restriction supports the conclusion that contact detection systems are patentably distinct from and not interchangeable with proximity detection systems.

It is also important to understand that the device disclosed in DE '771 is a circular saw bench while the device disclosed in Friemann is a band cutter. Those machines are constructed very differently and the differences would prevent the detection system disclosed in Friemann from being successfully implemented in the saw disclosed in DE '771. For example, the band cutter in Friemann moves in a path around three rollers and one pulley and a roller rolls along the side of the band cutter as the band cutter moves to couple the band cutter to the detection circuit. The band cutter does not move up or down or tilt so the roller remains in contact with the band cutter. The circular saw bench disclosed in DE '771, however, includes a circular blade that spins around an axis and the blade can be raised, lowered or tilted to accommodate different workpieces and to make different cuts. That spinning and changing of position would prevent the roller disclosed in Friemann from always remaining in contact with the circular blade. Thus, it is clear that the connection between Friemann's band cutter and circuit would have to be modified to work on a circular saw, but it is not clear how. The band cutter in Friemann must also be electrically isolated, and Friemann accomplishes that by placing a rubber covering on the periphery of the pulleys around which the band cutter moves. But the circular blade in DE

'771 is mounted on an arbor, it does not move around pulleys, so it would have to be isolated in some different way, but there is no teaching how. These differences between a circular saw bench and a band cutter show that there is no reasonable expectation that the detection system of Friemann could be successfully implemented in the saw shown in DE '771, and therefore, there is no motivation or suggestion to combine the references. MPEP 2143.02.

In short, combining DE '771 and Friemann results in a change of operation of DE '771 and there is no reasonable expectation that the resulting combination would be successful. Therefore, claim 1 in the present application is not obvious in light of that combination.

The Examiner rejected claims 5, 8 and 10 under 35 USC 103(a) as obvious in light of DE '771 in view of Friemann and Terauchi (US Patent 4,512,224). That rejection is traversed. Claim 8 has been cancelled so the rejection of that claim is moot. Claim 5 depends from claim 1 and is not obvious for the reasons given above. Claim 10 is not obvious because DE '771 and Friemann should not be combined, as explained above, and because claim 10 requires a braking component configured to engage the cutting tool, where engagement of the braking component with the cutting tool causes the cutting tool to pivot away from the cutting region. None of the cited references disclose any braking component configured to pivot a cutting tool away from a cutting region. MPEP 2143.03.

Claims 25-29 were rejected under 35 USC 103(a) as obvious in light of various combinations of Suzuki (US Patent 5,791,224), DE '771, Friemann and

Terauchi. Those rejections are traversed but are now moot because claims 25-29 have been cancelled without prejudice.

Allowable Subject Matter

The Examiner indicated that claims 19-24 would be allowable if rewritten in independent form including all the limitations of the base and intervening claims. Those claims have been rewritten in independent form and they have been amended to require a detection system adapted to detect a dangerous condition between a person and the blade instead of contact between a person and the blade.

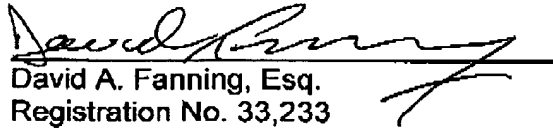
New Claims

Applicant is adding new claims 30-41. Claims 30-39 all require a reaction system configured to pivot a cutting tool at least partially away from a cutting region upon detection of a dangerous condition by the detection system. None of the cited references disclose any such reaction system. Claims 40 and 41 depend from claim 1 and further require a stop to limit the retraction of the cutting tool.

Conclusion

For the reasons discussed herein, applicant submits that all of the issues raised in the Office action mailed February 28, 2005 have been addressed and overcome, and therefore, the application should be allowed.

Respectfully submitted,
SD3, LLC



David A. Fanning, Esq.
Registration No. 33,233
Customer No. 27630
22409 S.W. Newland Road
Wilsonville, Oregon 97070
Telephone: (503) 638-6201
Facsimile: (503) 638-8601